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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,691	12/17/2001	Touru Terada	Q67592	8085
7590 01/05/2005			EXAMINER	
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue N.W. Washington, DC 20037			TRAN, LEN	
			ART UNIT	PAPER NUMBER
			1725	

DATE MAILED: 01/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/015,691	Applicant(s) TERADA ET AL.	
	Examiner Len Tran	Art Unit 1725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/29/04 has been entered.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, drawn to an apparatus, classified in class 29, subclass 740.
- II. Claims 5-7, drawn to a method, classified in class 228, subclass 103.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used to bond two different metals.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Election

5. Newly submitted claims 5-7 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The apparatus claims 1-3 can be used to bond different metals.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 5-7 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

6. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment to claim 1 consist of new matter, since the specification does not clearly explains a “control device to move the bonding tool” and “control device to move the substrate recognition camera”.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1- 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata et al (US 6,193,132), and further in view of Matsumoto et al (US 6,337,489).

Shibata et al disclose the apparatus for bonding comprising of a bonding tool (12), a moving mechanism for moving the bonding tool, **a chip recognition camera (14) disposed to be lower than a level of a substrate mounted surface of the substrate stage to thereby recognize the chip held by the bonding tool as shown in the figures (col. 6, lines 10-16).**

Shibata et al also disclose **a substrate recognition camera (16) disposed above the substrate**

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stage to recognize the substrate mounted on the substrate stage, and wherein the chip and substrate are subjected to positioning on the basis of recognition results of the chip recognition camera and the substrate recognition camera (figures 1, 5, 7, col. 4, lines 4-11, lines 25-37). In addition, Shibata inherently disclose a control device to control the bonding tool, since the bonding tool is moveable. Furthermore, the control device is also moving the substrate (11) as well as the recognition camera (14).

Shibata et al fail to disclose an up and down mechanism to control the bonding tool and a chip tray located lower than the bonding surface of the substrate.

However, Shibata et al disclose the bonding tool to move in a horizontal direction and the stage (10) move upward for bonding. Therefore, setting only the bonding tool to both move in the horizontal and vertical direction would have been obvious, since Shibata et al explicitly discloses such movement for bonding both chip and substrate.

However, Matsumoto et al is introduced to show the vertical movement of the bonding tool and the location of the chip tray to be lower than the level of the chip bonding surface of the substrate for the purpose of positioning the chip on the substrate with high precision.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to provide a vertical mechanism for moving the bonding tool and a lower chip tray as taught by Matsumoto et al, in Shibata et al in order to position the chip to the substrate with high precision.

Response to Arguments

10. Applicant's arguments filed 10/29/04 have been fully considered but they are not persuasive.

Applicant argues that Shibata fails to teach a bonding apparatus having a chip recognition camera disposed to be lower than a level of a substrate mounting surface of a substrate stage to thereby recognize a chip held by a bonding tool from a position below the chip, wherein a control device has moved the chip so that the chip recognition camera recognizes a lower surface of the chip when the lower surface of the chip is located substantially on a level with a chip bonding surface of the substrate. Examiner respectfully disagrees. Examiner had indicated earlier in the prosecution that the claimed language pertains to an apparatus. The apparatus of Shibata is capable of performing the claimed function, since it has all the claimed elements. Applicant further argues that examiner may not rely on measurements from Shibata's figures, since the drawings are not to scale. Examiner respectfully disagrees. Figures 1, 5, and 7 in Shibata is consistent with each other, showing the camera to be lower than the mounting surface for the substrate, in which the figures in Shibata is essentially the same as applicant's invention. Therefore, it is obvious to one of ordinary skill in the art to understand that the camera is lower than the mounting surface. In addition, if the camera is above the mounting surface, then upon raising the table (10), the camera would be restricted. Therefore, it is obvious to an ordinary skill in the art to placed the camera below the mounting surface. In conclusion, Shibata's drawing might not be shown in exact scale, however, it is obvious to one of ordinary skill in the art that Shibata's intention is to show the camera is below the mounting surface.

Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Len Tran whose telephone number is (571) 272-1184. The examiner can normally be reached on M-F, 8:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Len Tran
Examiner
Art Unit 1725



January 3, 2005